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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/900,684 | 07/06/2001 | Robert William Nabb | 13DV13928 | 6738 |
| 31450 | 7590 | 08/31/2005 | EXAMINER | |
| MCNEES WALLACE & NURICK LLC 100 PINE STREET P.O. BOX 1166 HARRISBURG, PA 17108-1166 | | | ROSEN, NICHOLAS D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3625 | |

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | |
|--|------------------------------------|
| Application No. 09/900,684 Examiner Nicholas D. Rosen | Applicant(s) NABB ET AL. |
| | Art Unit 3625 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 May 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-20 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 06 July 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/7/01 & 5/23/05</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____. |
|---|--|

DETAILED ACTION

Claims 1-20 have been examined.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it is 152 words long, slightly exceeding the proper length. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 1-11 are objected to because of the following informalities: In the seventh and eighth lines of claim 1, "wherein the first client computer being accessible by a user" should be either "wherein the first client computer is accessible by a user" or "the first client computer being accessible by a user". In the eleventh and twelfth lines of claim 1, "wherein the second client computer being accessible by a copy reproduction service provider" should be either "wherein the second client computer is accessible by a copy

reproduction service provider" or "the second client computer being accessible by a copy reproduction service provider". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg et al. (U.S. Patent Application Publication 2003/0140315) in view of official notice. As per claim 1, Blumberg discloses a system for submitting and monitoring copy reproduction order requests, the system comprising: a database to store information on copy reproduction requests, wherein the stored information comprises order information on copy reproduction requests and status

information on copy reproduction requests (paragraphs 42, 43, and 116, the database of appropriate information following inherently from the user's ability to determine the status of his job); a first client computer communicating with the database, the first client computer being accessible by a user (paragraphs 60, 61, 116, and 179-183); and an application for submitting and monitoring copy reproduction requests accessible on the first client computer by a user, the application comprising: means for entering order information on a copy reproduction request by a user (paragraphs 42, 43, and 116); and means for storing the entered order information on a copy reproduction request in the database (paragraph 116). Blumberg further discloses retrieving status information from the database on a copy reproduction request submitted by a user (paragraph 116). Blumberg does not expressly disclose an application for doing this on the user's client computer (the user might perhaps "query the order management software" by making telephone calls to a voicemail system, or even sending postcards with queries), but official notice is taken that it is well known to communicate with software on a server using an application on a client. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the application to comprise means for retrieving status information from the database on a copy reproduction request submitted by a user, for the obvious advantage of enabling the user to conveniently communicate with the order management software.

Blumberg does not disclose a second client computer communicating with the database to access the stored information on copy reproduction requests in the database, the second client computer being accessible by a copy reproduction service

provider, but official notice is taken that second clients for enabling service providers to access information from their servers are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for there to be such a second client computer, for the obvious advantage of enabling persons at the copy reproduction service provider to access information needed in doing their work.

As per claim 2, Blumberg discloses at least one file having material to be copied by the copy reproduction service provider, and means for uploading the at least one file having material to be copied to a database (paragraphs 42, 43, 135, 142-147).

As per claim 3, Blumberg discloses providing delivery information for the copy reproduction service provider to distribute completed copies, and management software for delivery, implying stored information comprising distribution information and means for uploading the distribution information (paragraphs 32-38, 45, 49, 74, and 117).

As per claim 4, Blumberg does not disclose an additional application accessible by a copy reproduction service provider on the second client computer, but official notice is taken that it is well known for clients to have applications, and in particular, to review information, download files, and update status information (the determination of status information disclosed in paragraph 116 of Blumberg would not make sense unless status information were updated as the status of orders changed). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for an additional application on the second client to comprise means for reviewing order information, means for downloading the at least

one file, and means for updating status information; for the obvious advantages of reviewing order information to carry out a reproduction job, or should any questions arise; and of downloading files to be reproduced, examined, or otherwise worked on; and the necessary advantage of updating status information.

As per claim 5, Blumberg discloses a server connected to a first client computer, the server computer comprising a storage device storing the application for submitting and monitoring copy reproduction requests (paragraphs 42-56, 60-62, 116, 174, 178-180, etc.). Blumberg does not disclose an additional server computer connected to the second client computer, the additional server computer comprising a storage device to store the additional application for processing copy reproduction requests. However, not only are servers storing data and programs well known in general, but official notice is taken that it is well known for information systems to comprise additional servers. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the system to comprise an additional server, for the obvious advantages of storing and carrying out the additional application, providing redundancy in case of difficulty with the first server, and providing additional security, by storing data not available on the first and publicly available server.

As per claim 6, Blumberg does not disclose means for a copy reproduction service provider to provide authentication information to access the additional application for processing copy reproduction requests stored on the additional server computer, but official notice is taken that it is well known to provide authentication information (e.g., a password) to access an application, database, computer, etc.

Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the system comprise means to provide authentication information to access the additional application for processing copy reproduction requests, for the obvious advantage of enabling access by authorized persons while preventing access by unauthorized persons, with the consequent ills of theft of services, release of confidential information, etc.

As per claim 7, Blumberg discloses an intranet from which the database can be accessed (paragraphs 27 and 41-44). Blumberg does not disclose that the additional application is accessed from the additional server computer on an Extranet, but official notice is taken that extranets are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the additional application to be accessed from the additional server on an Extranet, for the obvious advantage of enabling access by authorized users within one system or at authorized external locations.

As per claim 8, Blumberg does not disclose that the stored information on copy reproduction requests in the data is stored as binary large objects, but official notice is taken that binary large objects (BLOBs) are well known, and commonly used to store image data, among other data objects. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the stored information to be stored as binary large objects, for the obvious advantage of storing the information by suitable means.

As per claim 9, Blumberg does not disclose means for changing, by a user, the status information on a copy reproduction request in the database, but official notice is taken that it is well known for users to change status information on orders (e.g., to request that an order be made urgent, or to report on an order being received, or missing, etc.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the application to include means for changing, by a user, the status information on a copy reproduction request in the database, for the obvious advantage of enabling users to make such reports or requests.

As per claim 10, Blumberg does not disclose that the application comprises means for editing, by a user, the stored information on copy reproduction requests in the database, and means for filtering, by a user, the stored information on copy reproduction requests in the database, but official notice is taken that enabling users to edit and filter information in databases is well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the application to include means for editing and filtering the stored information by a user, for the obvious advantages of enabling users stored information (e.g., to make alterations to documents to be printed, or to the terms for printing them), and to readily find relevant files (filtering).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg and official notice as applied to claim 1 above, and further in view of Jones (U.S. Patent 6,224,387) and the anonymous article, "Internet Printing Solution Digitally

Enables Printing Service Bureaus," hereinafter "Internet Printing Solution." Blumberg does not expressly disclose that the means for entering order information on a copy reproduction request by a user comprises a copy order forms (although this could be considered to be implied by Figure 6 and paragraphs 64-99), but official notice is taken that forms for orders are well known. Hence, such a form would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the means to include such a form, for the obvious advantage of enabling the user to be conveniently informed of what data is to be entered, and given opportunity to enter it.

Blumberg does not expressly disclose a wide format order form and a CD-ROM reproduction order form (although Blumberg does disclose applying his system to all forms of printed matter, paragraph 29), but Jones teaches ordering a large, poster size reproduction (column 19, lines 53-65), and "Internet Printing Solution" teaches ordering reproduction on a CD-Rom (see especially paragraph beginning "Digital media jobs can include"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the means to include a wide format order form and a CD-ROM reproduction order form, for the obvious advantages of ordering these types of reproductions.

Claims 12, 13, 14, 15, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg et al. (U.S. Patent Application Publication 2003/0140315) in view of official notice. As per claim 12, Blumberg discloses submitting and monitoring copy reproduction order requests, including: a database to store information on copy

reproduction requests, wherein the stored information comprises order information on copy reproduction requests and status information on copy reproduction requests (paragraphs 42, 43, and 116, the database of appropriate information following inherently from the user's ability to determine the status of his job); and an application for submitting and monitoring copy reproduction requests accessible by a user, the application comprising: means for entering, by a user, order information on a copy reproduction request (paragraphs 42, 43, and 116); and means for storing the entered order information on a copy reproduction request in the database (paragraph 116). Blumberg further discloses retrieving status information from the database on a copy reproduction request submitted by a user (paragraph 116). Blumberg does not expressly disclose an application for doing this on the user's computer (the user might perhaps "query the order management software" by making telephone calls to a voicemail system, or even sending postcards with queries), but official notice is taken that it is well known to communicate with software on a server using an application on a client. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the application to comprise means for retrieving status information from the database on a copy reproduction request submitted by a user, for the obvious advantage of enabling the user to conveniently communicate with the order management software.

Blumberg does not disclose an additional application for processing copy reproduction requests, the additional application accessible by a copy reproduction service provider, but official notice is taken that it is well known for clients to have

applications, and in particular, to review information, download files, and update status information (the determination of status information disclosed in paragraph 116 of Blumberg would not make sense unless status information were updated as the status of orders changed). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for an additional application on the second client to comprise means for reviewing order information, means for downloading the at least one file, and means for updating status information; for the obvious advantages of reviewing order information to carry out a reproduction job, or should any questions arise; and of downloading files to be reproduced, examined, or otherwise worked on; and the necessary advantage of updating status information.

Blumberg does not expressly disclose a computer program product embodied on a computer readable and executable medium for submitting and monitoring copy reproduction order requests, but official notice is taken that it is well known for computers to have computer program products embodied on computer readable and executable media, and Blumberg certainly discloses computers, and in particular discloses applets (e.g., paragraphs 59-62). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have such a computer program product, for the obvious advantage of causing the server and clients to carry out their disclosed functions.

As per claim 13, Blumberg discloses at least one file having material to be copied by the copy reproduction service provider, and means for uploading the at least one file having material to be copied to a database (paragraphs 42, 43, 135, 142-147); the at

least one file having distribution information for the copy reproduction service provider to distribute completed copies, and management software for delivery, implying stored information comprising distribution information and means for uploading the distribution information (paragraphs 32-38, 45, 49, 74, and 117).

As per claim 14, Blumberg does not disclose that the means for downloading the order information comprises for downloading the at least one file having material to be copied from the database and means for downloading the at least one file having distribution information; however, given downloading of the file, and given material to be copied, and distribution information (which Blumberg discloses; see above), means for downloading the order information would presumptively comprise means for downloading at least one file comprising this information.

As per claim 15, Blumberg does not disclose means for a copy reproduction service provider to provide authentication information to access the additional application for processing copy reproduction requests stored on the additional server computer, but official notice is taken that it is well known to provide authentication information (e.g., a password) to access an application, database, computer, etc. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the system comprise means to provide authentication information to access the additional application for processing copy reproduction requests, for the obvious advantage of enabling access by authorized persons while preventing access by unauthorized persons, with the consequent ills of theft of services, release of confidential information, etc.

As per claim 16, Blumberg does not disclose that the application comprises means for editing the stored information on copy reproduction requests in the database by a user, and means for filtering the stored information on copy reproduction requests in the database by a user, but official notice is taken that enabling users to edit and filter information in databases is well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the application to include means for editing and filtering the stored information by a user, for the obvious advantages of enabling users stored information (e.g., to make alterations to documents to be printed, or to the terms for printing them), and to readily find relevant files (filtering).

As per claim 17, Blumberg does not disclose means for changing, by a user, the status information on a copy reproduction request in the database, but official notice is taken that it is well known for users to change status information on orders (e.g., to request that an order be made urgent, or to report on an order being received, or missing, etc.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the means for editing to include means for changing, by a user, the status information on a copy reproduction request in the database, for the obvious advantage of enabling users to make such reports or requests.

Claims 18, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg et al. (U.S. Patent Application Publication 2003/0140315)

in view of official notice. As per claim 18, Blumberg discloses a method of submitting a copy reproduction order request to a copy reproduction service provider, the method comprising the steps of: accessing, by a user, a copy reproduction application from a computer network (paragraphs 40-44, 65-76, etc.); selecting, by a user, a copy reproduction service to be provided by a copy reproduction service provider using the copy reproduction application (paragraphs 9, 10, and 67-82); completing, by a user, a copy reproduction order request for the selected copy reproduction service using the copy reproduction application (paragraphs 40-44, 65-76, and 99); storing the completed copy reproduction order request in a database, the completed copy reproduction order request including at least one file having material to be copied by the copy reproduction service provider (paragraphs 42, 43, 116, 135, and 142-147); and implies accessing, by the copy reproduction service provider, a plurality of copy reproduction order requests from the database using a service provider application (paragraph 116, querying the order management software implies accessing the orders on file). Blumberg does not expressly disclose downloading from the database, by the copy reproduction service provider the at least one file for making copies of the material to be copied, but does disclose making copies at appropriate printers in various locations (paragraphs 34 and 42), and official notice is taken that downloading files is well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to download the at least one file, for the obvious advantage of making it available to the printer for printing.

As per claim 19, Blumberg implies entering into the copy reproduction order request personal information of a user (paragraph 9, teaching of the user's name, etc., and paragraph 112, credit card information). Blumberg also discloses uploading the at least one file having material to be copied to a database (paragraphs 42, 43, 135, and 142-147).

As per claim 20, Blumberg discloses storing the completed copy reproduction order request in a file directory (paragraphs 42, 43, 116, 135, and 142-147, using the term "file directory" instead of "database"), but not transferring the completed copy reproduction order request from the file directory to the database. However, official notice is taken that it is well known to transfer files from one directory/database to another (e.g., for long storage). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transfer the completed copy reproduction order request from the file directory to the database, for the obvious advantages of making it available for access and downloading, and of saving space on a medium of limited storage capacity, and keeping files where there is more room.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bartman et al. (U.S. Patent 5,188,352) disclose a copy output stacker for engineering size copies (and discloses wide format copier/printers, see Abstract). Gillings et al. (U.S. Patent 5,666,490) disclose a computer network system and method for managing documents. Jecha et al. (U.S. Patent 6,631,375) disclose an administration and search and replace of computerized prepress. Chase et al. (U.S. Patent 6,529,214) disclose an interactive print job display system and method. Ackaret (U.S. Patent 6,799,297) discloses a form printing solutions web server using a Java vending machine for pulling a jetsend form print job from a server and outputting to a device. Grasso et al. (U.S. Patent 6,873,430) disclose a knowledge management system and method.

The Microsoft Press Computer Dictionary discloses the definition of "extranet" (page 187).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

August 24, 2005